



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/893,775 | 06/29/2001 | Will H. Gardenswartz | OBSP5GARD-USC2 | 5962 |

31518 7590 08/16/2006

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA, VA 22304

| |
|----------|
| EXAMINER |
|----------|

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|--|--|--|
| Notification of Non-Compliant Appeal Brief (37 CFR 41.37) | Application No. 09/893,775 | Applicant(s) GARDENSWARTZ ET AL. | |
| | Examiner Donald L. Champagne | Art Unit 3622 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 30 May 2006 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

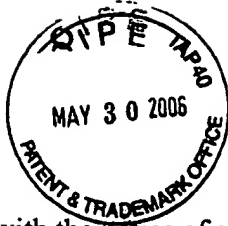
1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☒ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)). *See attached correction sheet*
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☒ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)). *See attached correction sheet*
6. ☒ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and **relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☐ Other (including any explanation in support of the above items):

Item 6 above: Appellant defines four grounds of rejection, but has the argument under 10 headings, G.1. to G.10. The arguments must be presented under FOUR headings, not 10.

*Attachments
Two prior correction sheets
one sub: tute
form 1479*

[Signature]
DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit: 3622



I. **37 CFR 41.37 (a)**

This brief is filed with the notice of appeal under 41.31 and is accompanied by the fee set forth in 37 CFR 41.20(b)(2), and sets forth the authorities and arguments on which the appellant will rely to maintain the appeal.

II. **37 CFR 41.37 (b)**

The filing is timely – within three months of the office action mailed February 27, 2006. Accordingly, this subsection is not relevant.

III. **37 CFR 41.37 (c)(1)**

A. **37 CFR 41.37 (c)(1)(i) Real Party in Interest**

The real party in interest is Catalina Marketing International, Inc., a Delaware corporation, which is wholly owned by Catalina Marketing Corporation, a Delaware corporation.

B. **37 CFR 41.37 (c)(1)(ii) Related Appeals and Interferences**

There are no related appeals or interferences. Accordingly, this section is inapplicable.

C. **37 CFR 41.37 (c)(1)(iii) Status of Claims**

Claims 1 and ~~55-87~~ are pending. Claims 1 and ~~55-87~~ are rejected and under appeal.

Claim
56 was
cancelled

55 and 57-87

D. **37 CFR 41.37 (c)(1)(iv) Status of Amendments**

All amendments are entered.

E. **37 CFR 41.37 (c)(1)(v) Summary of Claimed Subject Matter**

The invention of claim 1 is a method for delivering a targeted advertisement, comprising: receiving from a first computer a first identifier identifying the first computer (page 4 lines 21-23) and associated by a purchase behavior classification with an observed offline purchase history of a consumer (page 4 lines 23-25; page 15 lines 6-8), said purchase history including purchase history information of an offline purchase of a consumer collected when the

Attachment 1 to
Notification of Non-Compliance
Appellate Brief

The invention of claim 87 is a computer network system for delivering targeted advertisements, comprising: means for collecting, during an offline purchase transaction of a first consumer, a first consumer offline purchase history data and a first customer identification for said first consumer (page 15 lines 17-13; page 15 line 29 to page 16 line 4; Figure 6); means for storing said first consumer offline purchase history data in association with said first consumer identification (page 15 lines 24-28); means for receiving from a consumer computer a first identifier (page 16 lines 12-22); means for associating said first identifier with said first consumer identification which is associated with said first consumer offline purchase history data (page 17 lines 20-27); means for determining a targeted advertisement for said first consumer based at least in part on said offline purchase history associated via said first consumer identification with said first identifier (page 19 line 26 to page 20 line 3); and means for delivering said determined targeted advertisement to said first consumer (page 21 lines 4-5).

F. 37 CFR 41.37 (c)(1)(vi) Grounds of Rejection to be Reviewed on Appeal

Whether the rejection of claim 1 under 35 USC 103(a) as being obvious over Biorge et al. (USP 5,806,045, hereinafter "Biorge") in view of Stein et al. (USP 5,459,306, hereinafter "Stein") and Herz et al. (USP 5,754,938, hereinafter "Herz") is improper and should be reversed.

Whether the rejections of claims ⁵⁷55, ⁷¹⁻⁷⁴56, 62-69, ^{103(a)}72, 86, and 87 under 35 USC ~~102(b)~~ as obvious over Stein in view of Merriman et al. (USP 5,948,061, hereinafter "Merriman") are improper and should be reversed.

Whether the rejections of claims ⁵⁷57, ^{58, 60, 61}61, ⁷⁵71, and ⁷³⁻⁸⁵73-85 under 35 USC 103(a) as obvious ^{in view of Merriman} over Stein, based on the examiner's official notice, are improper and should be reversed.

Whether the rejection of claim 70 under 35 USC 103(a) as obvious over Stein in view of Merriman and further in view of De Lapa et al. (USP 6,076,068, hereinafter "de Lapa") is improper and should be reversed.

3 Attachment 2 to
notification of
non-compliant appeal
Brief